

REMARKS

The Examiner is thanked for the thorough examination of the present application. In the outstanding Office Action, claims 1-31 were rejected under 35 USC §102. By this Amendment, claim 1 is amended. Support for the amendment of claim 1 can be found at least at claim 3 and page 4, line 26 through page 5, line 2 of the present Application.

Currently pending claims 1, 2 and 4-31 are believed allowable, with claims 1, 14, 15 and 21 being independent claims.

REJECTIONS UNDER 35 USC §102

Claims 1-31 were rejected under 35 USC §102(e) as allegedly anticipated by U.S. Patent Document No. 2004/0230459 ("Dordick"). The MPEP § 2131 defines the standard for anticipation as follows:

The identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Claim 1

Claim 1 recites, in part, "A method for embedding an agreement between a device provider and a device user in a device." The Examiner asserts that Dordick discloses the

following, "a method for embedding an agreement (110, paragraph 36) between a device provider (104) and a device user (106) in a device."

The Examiner fails to identify a device as recited in claim 1 in which an agreement is embedded. As such, the *prima facie* case of anticipation fails because the identical invention is not shown in as complete detail as is contained in the claims since the elements cited by the Examiner fail to read on each and every claimed element.

Claim 1 further recites, in part, "storing the agreement as computer readable code in the device." Responding to this claim element, the Examiner argues, "It is inherent that the agreement is stored in the device of Fig. 1." Office Action, pp. 3, item 9. The Applicants disagree.

Figure 1 of Dordick shows a network environment 102 including a service purchaser 106, a service provider 104 and an insurance provider 114 coupled via a network 108. Thus, there are several entities shown, not a single "device." The interpretation that Figure 1 is a single device is unreasonable, especially in light of the Examiner's previous statement that the "device" of Figure 1 includes a device provider (104) and a device user (106).

Furthermore, the Examiner fails to meet the standard outlined in MPEP 2112 § IV that states, "the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic", and/or, "in relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the

teachings of the applied prior art". The Examiner makes no attempt to explain the determination that the agreement is stored somewhere in Figure 1 of Dordick.

Claim 2

Claim 2 is dependent on claim 1 and recites, "The method of Claim 1, further comprising if the event occurred, indicating that the event occurred at the device." It is noted that that, based on antecedent reference in the claims, claim 2 requires the indicating that the event occurrence take place at the subject device of the agreement between the device provider and the device user.

In rejecting claim 2, the Office Action alleges Dordick indicates that an event occurred at the device. Office Action, pp. 2, item 8. The Examiner cites paragraph 39 of Dordick in support of this argument. The Applicants respectfully disagree with this position.

Paragraph 39 of Dordick states,

At query operation 310, the insurance provider checks whether there has been a change to any of the measured risk metrics. If no change has occurred, control returns to providing operation 304. If, on the other hand, there has been a change to any of the measured risk metrics, control passes to adjusting operation 312.

Paragraph 39 does not disclose indicating an event occurrence, let alone making such an indication at the device. For at least this reason, and the reasons given for claim 1, it is respectfully submitted that Dordick fails to anticipate the limitations of claim 2. Thus, claim 2 is believed allowable and indication of such allowance is earnestly requested.

Claim 4

Claim 4 is dependent on claim 1 and recites, "The method of Claim 1, further comprising enforcing the agreement at the device." It is noted that that, based on antecedent reference in the claims, claim 4 requires enforcing the agreement at the subject device of the agreement between the device provider and the device user.

In rejecting claim 4, the Office Action alleges Dordick discloses enforcing an agreement at the device at paragraphs 20 and 21. Office Action, pp. 3, item 10. The Applicants respectfully disagree with this position.

Paragraphs 20 and 21 of Dordick state,

Absent an explicit service level agreement 110, the service provider 104 may still be liable for not achieving quality of service levels. Such liability generally results from an implicit service agreement created between the service provider 104 and the service purchaser 106 as a result of representations made by the service provider, advertising or de facto industry standards. It is therefore contemplated that the present invention may still be utilized when no explicit service agreement 110 or an incomplete service agreement 110 exists between the service provider 104 and the service purchaser 106.

In undertaking to provide service to the service purchaser 106, the service provider 104 typically assumes a certain degree of risk as a result of explicit or implicit quality of service guarantees. Some risk may be involuntarily assumed by the service provider 104, while other risk may be voluntary. Involuntary risk includes risk that cannot be easily controlled by the service provider 104. Such involuntary risk includes risk from fire, theft, personnel errors, fluctuations in service demand, market conditions, and so on. Voluntary risk, on the other hand, involves more controllable aspects of the service provider's business that contribute to how often the service provider 104 violates the quality of service guarantees and incurs penalties. Examples of voluntarily assumed risk include the amount of resources devoted by the

service provider 104 to the service purchaser 106 and the service level guarantees made.

Paragraphs 20 and 21 discuss situations where a service level agreement does not exist and the assumption of risk by a service provider. The Applicants submit is no teaching or suggestion in this paragraph of enforcing an agreement in any device, much less a subject device of an agreement between a device provider and a device user.

For at least these reasons, and the reasons given for claim 1, it is respectfully submitted that Dordick fails to anticipate the limitations of claim 4. Thus, claim 4 is believed allowable and indication of such allowance is earnestly requested.

Claim 5

Claim 5 is dependent on claim 4 and recites, "The method of Claim 4, wherein enforcing the agreement includes disabling at least some of the capabilities of the device if the event occurred." It is noted that that, based on antecedent reference in the claims, claim 5 requires disabling capabilities of the subject device of the agreement between the device provider and the device user.

In rejecting claim 5, the Office Action alleges Dordick discloses disabling at least some of the capabilities of a device if an event occurred at paragraphs 20 and 21. Office Action, pp. 3, item 11. The Applicants respectfully disagree with this position.

Paragraphs 20 and 21 discuss situations where a service level agreement does not exist and the assumption of risk by a service provider. The paragraphs make no mention of disabling at least some of the capabilities of a device if an event occurred,

much less a subject device of an agreement between a device provider and a device user.

For at least these reasons, and the reasons given for claims 1 and 4, it is respectfully submitted that Dordick fails to anticipate the limitations of claim 5. Thus, claim 5 is believed allowable and indication of such allowance is earnestly requested.

Claim 6

Claim 6 is dependent on claim 4 and recites, "The method of Claim 4, wherein enforcing the agreement includes enabling at least some of the capabilities of the device if the event occurred." It is noted that that, based on antecedent reference in the claims, claim 6 requires enabling capabilities of the subject device of the agreement between the device provider and the device user.

In rejecting claim 6, the Office Action alleges Dordick discloses enabling at least some of the capabilities of a device if an event occurred. Office Action, pp. 3, item 12. The Examiner cites items 314 and 316 of Figure 3B of Dordick in support of this argument. The Applicants respectfully disagree with this position.

Item 314 and 316 of Figure 3B of Dordick are shown below.

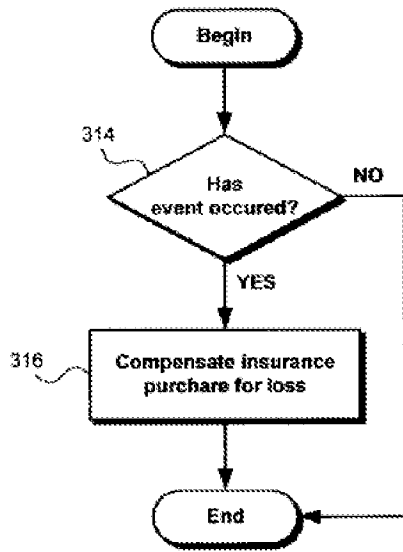


Fig. 3B

The Applicants submit is no teaching in item 314 and 316 of enabling capabilities of a device if an event occurred, much less a subject device of an agreement between a device provider and a device user.

For at least these reasons, and the reasons given for claims 1 and 4, it is respectfully submitted that Dordick fails to anticipate the limitations of claim 6. Thus, claim 6 is believed allowable and indication of such allowance is earnestly requested.

Claim 7

Claim 7 is dependent on claim 1 and recites, "The method of Claim 1, further comprising representing the agreement as a Boolean expression of at least one condition, the condition based on the parameter."

In rejecting claim 7, the Office Action alleges Dordick discloses representing an agreement as a Boolean expression of

at least one condition, the condition based on a parameter. Office Action, pp. 3, item 13. The Examiner cites paragraphs 32 and 33 of Dordick in support of this argument. The Applicants respectfully disagree with this position.

Paragraph 32 and 33 of Dordick state,

[0032] In FIGS. 3A and 3B, flowcharts for indemnifying an insurance purchaser by an insurance provider against a loss resulting from at least one specified event, as contemplated by one embodiment of the present invention, are shown. It should also be remarked that at least some of the logical operations shown may be implemented (1) as a sequence of computer executed steps running on a computing system and/or (2) as interconnected machine modules within the computing system. The implementation is a matter of choice dependent on the performance requirements of the system implementing the invention. Accordingly, the logical operations making up the embodiments of the present invention described herein are referred to alternatively as operations, steps, or modules.

[0033] Operational flow begins with receiving operation 302. During this operation, the insurance provider receives a request for insurance coverage from the insurance purchaser. The request is typically accompanied with or followed by information about the insurance coverage required by the insurance purchaser, and includes the event or events that the insurance purchaser wishes to be protected against, as well as the amount of protection required. In the example where the insurance purchaser is a service provider, the information received may be a request for insurance against quality of service penalties. The information may specify the amount of insurance coverage, deductibles and premiums. Furthermore, the information may describe the service provider's infrastructure, customer usage, service agreements, and various other attributes that may affect the service provider's exposure to quality of service penalties. After the receiving operation 302 is completed, flow continues to providing operation 304.

The Applicants respectfully submit there is no mention or suggestion in paragraphs 32 and 33 of Dordick of representing an agreement as a Boolean expression of at least one condition, the condition based on a parameter.

For at least these reasons, and the reasons given for claim 1, it is respectfully submitted that Dordick fails to anticipate the limitations of claim 7. Thus, claim 7 is believed allowable and indication of such allowance is earnestly requested.

Claim 9

Claim 9 recites, "The method of Claim 8, further comprising indicating violation of the agreement on the device." It is noted that that, based on antecedent reference in the claims, claim 9 requires indicating violation of the agreement on the subject device of the agreement between the device provider and the device user.

In rejecting claim 9, the Office Action alleges Dordick discloses enforcing the agreement at the device. Office Action, pp. 3, item 15. The Examiner cites paragraph 37 of Dordick in support of this argument. The Applicants respectfully disagree with this position.

Paragraph 37 of Dordick states,

In one embodiment of the invention, the insurance provider automatically monitors the insurance risk metrics at regular intervals via the network. For example, the insurance provider may check a risk metric's value every minute or every hour. In another embodiment the insurance provider is automatically notified when the metrics have significantly changed. For example, the insurance provider may be automatically notified when a risk metric has changed beyond a threshold percentage of its value.

Paragraph 3 of Dordick describes a capability of an insurance provider monitoring insurance risk metrics at regular intervals via a network. The Applicants submit is no teaching or suggestion in this paragraph of indicating violation of an agreement on a subject device of an agreement between the device provider and the device user.

For at least this reason, it is respectfully submitted that Dordick fails to anticipate the limitations of claim 9. Thus, claim 9 is believed allowable and indication of such allowance is earnestly requested.

Claims 8 and 10-13

Claims 8 and 10-13 are dependent on and further limit claim 1. Since claim 1 is believed allowable, claims 8 and 10-13 are also believed allowable for at least the same reasons as claim 1.

Claim 14

Claim 14 recites, in part, "A method for embedding an agreement between a software module provider and a software module user in a software module." As discussed above for claim 1, Dordick does not teach or suggest embedding an agreement between a software module provider and a software module user in a software module.

The Office Action rejects claim 14 "for the same rationale as claims 1-13, since [it recites] substantially identical subject matter." Office Action, pp. 4, item 20. The Applicants respectfully disagree with this position and request clarification from the Examiner of where in claims 1-13 the subject matter of claim 14 is recited.

For at least these reasons, it is respectfully submitted that Dordick fails to anticipate the limitations of claim 14. Thus, claim 14 is believed allowable and indication of such allowance is earnestly requested.

Claim 15

Claim 15 recites, in part, "a representation of the agreement embedded in the device." As discussed above for claim

1, Dordick does not teach or suggest embedding a representation of an agreement in a device.

The Office Action rejects claim 14 "for the same rationale as claims 1-13, since [it recites] substantially identical subject matter." Office Action, pp. 4, item 20. The Applicants respectfully disagree with this position and request clarification from the Examiner of where in claims 1-13 the subject matter of claim 15 is recited.

For at least these reasons, it is respectfully submitted that Dordick fails to anticipate the limitations of claim 15. Thus, claim 15 is believed allowable and indication of such allowance is earnestly requested.

Claim 16

Claim 16 is dependent on claim 15 and recites, "The device of Claim 15, wherein the agreement is legally unenforceable." The Office Action rejects claim 16 "for the same rationale as claims 1-13, since [it recites] substantially identical subject matter." Office Action, pp. 4, item 20. The Applicants respectfully disagree with this position and request clarification from the Examiner of where in claims 1-13 the subject matter of claim 16 is recited.

Claim 17

Claim 17 is dependent on claim 15 and recites, "The device of Claim 15, wherein the determining module is configured to determine if the event is likely to occur in the near future, and the alert module is configured to indicate that the event is likely to occur in the near future." The Office Action rejects claim 17 "for the same rationale as claims 1-13, since [it recites] substantially identical subject matter." Office Action, , pp. 4, item 20. The Applicants respectfully disagree

with this position and request clarification from the Examiner of where in claims 1-13 the subject matter of claim 17 is recited.

Claim 18

Claim 18 is dependent on claim 15 and recites, "The device of Claim 15, further comprising a data aggregation module configured to aggregate the data from the at least one parameter." The Office Action rejects claim 18 "for the same rationale as claims 1-13, since [it recites] substantially identical subject matter." Office Action, pp. 4, item 20. The Applicants respectfully disagree with this position and request clarification from the Examiner of where in claims 1-13 the subject matter of claim 18 is recited.

Claims 19 and 20

Claims 19 and 20 are dependent on and further limit claim 15. Since claim 15 is believed allowable, claims 19 and 20 are also believed allowable for at least the same reasons as claim 15.

Claims 21-31

Claims 21-31 were rejected "for the same rationale as claims 1-13." Office Action, pp. 4, item 20. Thus, the Applicants submit claims 21-31 are allowable for at least the same reasons given above for claims 1-13.

CONCLUSION

In view of the forgoing remarks, it is respectfully submitted that this case is now in condition for allowance and such action is respectfully requested. If any points remain at issue that the Examiner feels could best be resolved by a

telephone interview, the Examiner is urged to contact the attorney below.

No fee is believed due with this Amendment, however, should a fee be required please charge Deposit Account 50-0510. Should any extensions of time be required, please consider this a petition thereof and charge Deposit Account 50-0510 the required fee.

Dated: July 7, 2009

Respectfully submitted,

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